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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): Asundi *et al.*

APPLICATION NUMBER: 10/084,643

EXAMINER: Not yet assigned

FILING DATE: February 26, 2002

ART UNIT: 1631

FOR: NOVEL NUCLEIC ACIDS AND POLYPEPTIDES

Commissioner for Patents
Box Missing Parts
Washington, D.C. 20231

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OFFICE OF PETITIONS

**PETITION UNDER 37 CFR 1.53 TO ESTABLISH PRIOR RECEIPT IN THE USPTO
OF ITEMS CONSIDERED AS OMITTED BY THE USPTO**

1. This is in response to the "NOTICE TO FILE MISSING PARTS OF A NONPROVISIONAL APPLICATION" mailed on May 9, 2002. A copy of this Office Action is enclosed. The Notice states that pages 213-679 and 1176-9856 of the specification appeared to have been omitted from the application filed February 26, 2002.
2. The patent application was filed using the Express Mail provision of 37 CFR 1.10. It was deposited with the U.S. Postal Service on February 26, 2002, bearing Express Mail Label EV058116020US. The application contained a specification of 10966 total pages, which included 2 CD-ROMs, as was indicated on both the Transmittal Letter and the Return Postcard. Copies of these documents are provided with the enclosed Evidence of Deposited Items as Exhibit A.
3. Part of the specification was provided in paper format. Pages 1-213 (the specification including the abstract), pages 680-944 (Table 5), pages 1032-1175 (Table 7), pages 9857-10960 (Tables 23-25) and pages 10961-10966 (claims) were submitted in paper format.
4. The remainder of the specification was provided in computer readable format supplied on duplicate CD-ROMs as required by 37 CFR 1.52(e). Each CD-ROM contained a total of nineteen (19) files, and each disc was marked as required by 37 CFR 1.52(e)(6) to indicate the name of the inventor, title of the invention, attorney docket number, and date. Each CD-ROM further indicated the computer type and operating system type that created, and was capable of, reading the contents. The discs were labeled "Copy 1" and "Copy 2" in accordance with 37 CFR 1.52(e)(4) and 37 CFR 1.52(e)(6)(vi). Although

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two CDs were submitted, both are complete copies of each other and as such, the Applicants further believe these are not multiple submissions for the purpose of 37 CFR 1.52(e)(6)(v).

5. Applicants assert that the pages of the specification that were said to be omitted, i.e., pages 213-679 and 1176-9856, were in fact deposited with the USPTO with the original application filed on February 26, 2002, in electronic format on these two (2) duplicate CD-ROMs, in accordance with 37 CFR 1.52(e). When viewed by computer using Microsoft Word 2000[®] or when printed in hard copy format, the information is numbered contiguously with the paper copy of the specification. Printed copies of the first and last pages from each of the 19 files contained on the CD-ROMs, illustrating this, are provided with the enclosed Evidence of Deposited Items as Exhibit B. The subject matter of these files are briefly described:
 - a. The pages 213-679 of the specification correspond to Tables 2, 3, and 4. These tables describe the following:
 - i. The results of nearest neighbor searches against the Genbank database using BlastN (Table 2) and FastA (Table 3) algorithms; and
 - ii. The tissue sources of EST sequences used to assemble the contiguous nucleic acid sequences (Table 4).
 - b. The pages 1176-9856 of the specification correspond to Tables 8-22. These tables describe the following:
 - i. The polypeptides encoded by the disclosed polynucleotides and their corresponding nucleotide locations relative to each of these sequences (Tables, 8, 14, and 20)
 - ii. The results of nearest neighbor searches against the Genbank database using BlastN and FastA algorithms (Tables 10, 13, 16, 19, and 22); and
 - iii. The tissue sources of EST sequences used to assemble the contiguous nucleic acid sequences (Tables 9, 11, 12, 15, 17, 18, and 21).
 - c. Pages 945 through 1031 were also provided in electronic format on the CD-ROMs. The PTO has **not** asserted that these pages were unreceived, however. For avoiding confusion, these pages represent Table 6, which describes nearest neighbor searches against the Genbank database using BlastN and FastA algorithms.

6. In accordance with 37 CFR 1.52(e)(5) and 37 CFR 1.77(b)(4), the specification contains specific references to each of the 19 files, by file name, on the CD-ROMs, thus incorporating the material by reference. The pages of the specification that reference these 19 electronic files are provided with the enclosed Evidence of Deposited Items as Exhibit C. For example, pages 19-20 of the specification identifies the electronic files and their relationship to information provided in parent applications, thus incorporating this material by reference. In particular, Example 6.0 on page 193 of the specification recites:

Selected tables are provided on the CD-ROM, supplied concurrently with this application. The entirety of the contents of the CD-ROM are intended to be a part of this application, and are incorporated by reference. The electronic file name, where appropriate, follows the first reference to the table throughout the application.

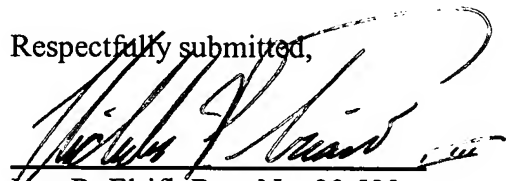
7. In accordance with the requirements on the Notice of June 5, 1996, 61 Fed. Reg. 30,041-30,046, Applicants hereby:
- a. Petition under 37 CFR 1.53(e) for a review of the determination that the items in issue were omitted;
 - b. Submit the petition fee under 37 CFR 1.17(h); and
 - c. Submit the attached evidence of the deposit of the items in issue.

Applicants respectfully submit that grant of the petition is in order and is respectfully requested.

8. Fee Payment and Request for Refund

A check is attached in the sum of \$130.00 for the petition fee, as set forth in 37 CFR 1.17(h). Please credit any overpayment or charge any underpayment for this petition to Account No. 50-0311, Reference No. 21272-502. A duplicate of this paper is attached. It is respectfully requested that, upon grant of the petition under 37 CFR 1.53(e), the petition fee be refunded by deposit to Account 50-0311, Reference No. 21272-502.

Respectfully submitted,



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